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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/134,831	08/17/1998	RICHARD P. METTKE	6388.005	8517

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/134,831

Applicant(s)
Mettke

Examiner
Stella Woo

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Drawings

1. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent for the same reasons given in the last Office action. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, and credit card reader in the manner depicted in the current Figure 2. Correction is required.

2. The proposed substitute sheet of drawings (substitute Figure 2), filed on April 17, 2000 has been disapproved because it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a housing incorporating a monitor, keyboard, and credit card swipe device in the manner depicted such that the substitute Figure 2 does not remedy the objection to the drawings given in the last Office action and repeated above.

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Specification

3. As previously addressed in the last Office action (paragraph 4), new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Objections

4. Claim 9, as amended in the paper filed December 11, 2001, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 9 recites a "CPU, monitor, credit card reader swipe device, internal modem and printer." These limitations are already recited in claim 6, from which claim 9 depends.

Applicant is required to cancel the claim or amend the claim to place the claim in proper dependent form.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 7, as amended in the paper filed December 11, 2001, recites "a keyboard which communicates with and controls a microprocessor" which is not supported by the original disclosure as filed on January 23, 1995. The original disclosure makes no mention of the keyboard controlling a microprocessor. Furthermore, there is no provision in the original disclosure for "a microprocessor" in addition to the "CPU" already recited in claim 6, upon which claim 7 depends.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article") for the same reasons given in the last Office action and repeated below.

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

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a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);
means for accessing and allow for user interaction (via touchscreen and computer modem;
Exhibit E, second page, second column, second paragraph);
a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph,
line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to

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specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5).

Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, as described above with regard to claim 6, Exhibit E provides for a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3), a monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph), a credit card reader swipe device (Exhibit E, second page, first column, second paragraph, lines 4-6), an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11), and a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

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Response to Arguments

9. Applicant's arguments filed December 11, 2001 have been fully considered but they are not persuasive.

Regarding the objection to Figure 2, applicant argues that the components depicted in Figure 2 are disclosed in the original specification. The examiner contends that the disclosure fails to provide for the terminal as comprising the various components in the manner depicted in Figure 2, that is, within a single housing. Rather, Figure 2, as *originally* filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2.

Again, applicant points to other U.S. Patents listed in the specification as providing support for the terminal housing incorporating a monitor, keyboard, and credit card reader. However, this passage refers to various capabilities in prior U.S. patents to other inventors; it does not describe applicant's own invention as including a housing incorporating the depicted elements. Nowhere in the original specification is there any description of a terminal housing incorporating all the elements of Figure 2. Applicant cannot rely on references to other U.S. patents to provide support for subject matter missing from applicant's own written description.

In response to applicant's argument that there is no suggestion to combine the references (Exhibits E and F with the Shah article), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Exhibits E and F

differs from claim 6 in that it does not specify accessing and interfacing with the Internet.

However, the combination does allow for accessing and interfacing with a remote service provider

via a modem and the Shah article teaches the desirability of providing access to and interaction

with the Internet in a kiosk-based information system (pages 1-2, section entitled "The

Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of

appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to

provide users with access to the many services on the Internet including a paid service by

commercial organizations which charges customers for access to specific services (page 2, section

entitled "Who will use these systems?" and page 5, lines 11-12). The examiner maintains that it

would have been obvious to an artisan of ordinary skill to incorporate such means for accessing

and software for interfacing with the Internet in a kiosk information system, as taught by the Shah

article, within the combination of Exhibits E and F in order to provide users with access to the

many services available on the Internet. In this way, the user is not limited to retrieving

information from only one remote service provider.

Applicant further argues that "[n]one of the references discloses or suggests the use of a credit card swipe device to access the Internet." The examiner contends that the combination

clearly provides for a credit card swipe device (Exhibit E shows a credit card reading device for

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accepting payment to retrieve information from a remote service provider; second page, first column, second paragraph, lines 4-6) such that the combination of Exhibits E, F and Shah would result in the use of the credit card reader swipe device to pay for the ability to retrieve information from the Internet.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

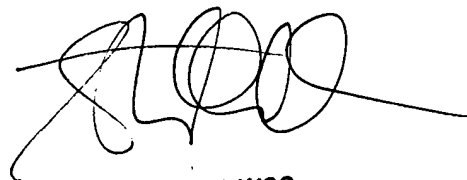
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or faxed to:

(703) 872-9314; (for formal communications, please mark "EXPEDITED PROCEDURE"; and for informal or draft communications, please label "PROPOSED" or "DRAFT").

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

March 11, 2002

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

**STELLA WOO
PRIMARY EXAMINER**